

REMARKS

Support for the correction of Figures 1, 4 and 5A and amendments to the specification are found in application Figures 1-5A. As such, it is submitted that no new matter has been added to the application by way of this amendment.

Claims 1, 3 and 10 currently stand rejected under 35 U.S.C. §103(a) over Solomon et al. (US 2003/0025316) in view of Ristow et al. (U.S. 1,861,136) and Funk et al. (U.S. 6,269,169). Claims 2, 7 and 11 currently stand rejected under 35 U.S.C. §103(a) over Solomon et al. in view of Ristow et al., Funk et al. and further in view of Prescott et al. (U.S. 6,805,459). Lastly, claim 13 stands rejected under 35 U.S.C. §103(a) over Solomon et al. in view of Ristow et al., Funk et al. and further in view of Heinze III (U.S. 6,047,802).

Remarks Directed to Rejection of Claims 1, 3 and 10 Under 35 U.S.C. §103(a) Over Solomon et al. in View of Ristow et al. and Funk et al.

In *In re Wesslau* (1965), the Court of Customs and Patent Appeals cautioned that “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 147 USPQ 391 (CCPA 1965). The Federal Circuit has held that a single line in a prior art reference taken out of context and relied upon with the benefit of hindsight is impermissible to show obviousness. Instead, a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986), *cert denied*, 484 U.S. 823 (1987). Also, the Federal Circuit noted “A reference may be said to teach away when a person of ordinary skill, upon reading the reference,

would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 7 F.3d 551, 31 USPQ2d 1130 (Fed. Cir. 1994).

Solomon et al. is cited for the teachings provided in Figures 1-3 that includes:

indicia readable under light having a wavelength of between 350 and 400 nanometers, see paragraph [0015], and an ultraviolet light source/flashlight (see figures 3). . . . Solomon et al. does not disclose whether a first ink readable under visible light is provided on the stationery [sic] and the use of the light emitting diode as the light source. Ristow et al. shows in figures 1-3 a stationery article in the form of a greeting card that includes a first ink (the pictures and words in figures 1 and 3) readable under visible light. In view of the teachings of Ristow et al. it would have been obvious to one in the art to modify Solomon et al. by placing a first ink readable under visible light onto the stationery/greeting card since this would make the stationery/greeting card more aesthetically pleasing and would allow a desired message to be conveyed to all viewers of the stationery/greeting card. Funk et al. discloses in column 4, lines 54-55 the idea of using light emitting diodes as a ultraviolet light source. (Paper No. 5, page 5, last paragraph).

Applicant submits that the use of the “ultraviolet light emitting diode flashlight having a light source consisting of: a single light emitting diode and having a light emission of between 350 and 400 nanometers” affords a surprising benefit over the prior art combination of record. The importance of a single light emitting diode and having a light emission of between 350 and 400 nanometers makes the claimed greeting card a practical item whereas the light source producing ultraviolet illumination according to the prior art reference combination represents a size and complexity that would render a greeting card according to the prior art combination impractical. Applicant agrees with the characterization of the teachings of Solomon et al. with the exception that (a) the ultraviolet “lamp or light fixture” [0012] lacks the portability and dimensions so as to be construed as a flashlight; and (b) Solomon et al. teaches ultraviolet

illumination with a wavelength of between 350 and 380 nanometers as opposed to 350 and 400 nanometers.

Applicant notes that the problem Solomon et al. attempts to overcome is drawing attention to the diary or journal [0002], something quite opposite to the present application. Solomon et al. teaches away from the present application by stating that the prior art has “security measures” to make writing content “more secure and prevent or limit unwanted access” [0002] and that the “present invention advances the security of written, drawn or printed content ...” [0003]. The use of stationery as taught by Solomon et al. also falls within the teaching of keeping the written content “more secure.” The notion that one skilled in the art would be motivated to include visible light printed indicia per Ristow et al. onto the stationery of Solomon et al. to make it aesthetically pleasing and allow the desired message to be conveyed to all viewers of the greeting card is contrary to the purpose of Solomon et al. in providing a diary or stationery that appears empty to viewers other than the writer. In other words, Solomon et al. fails to provide a motivation to include indicia visible under ambient light which draws attention to the diary and teaches away from the present invention. Applicant submits that the only motivation to combine visible and invisible markings in the context of a greeting card is found in the pending application. Funk et al. fails to provide a motivation for placing visible ink indicia onto an ultraviolet ink indicia covered surface and as such fails to rescue the prior art reference combination.

Additionally, the ultraviolet light emitting diode flashlight as recited in independent claim 1 reduces the size and complexity as compared to the lamp or light fixture according to Solomon et al. In the context of a greeting card, longevity of a flashlight is not an issue. Rather, the ability to reasonably package an ultraviolet light in an envelope and at a cost commensurate with

a disposable greeting card are features associated with the present invention not found in the prior art reference combination. The notion of leveraging the teaching of Funk et al. to replace the ultraviolet lamp according to Solomon et al. fails to achieve the attributes of the claimed invention since Funk et al. only recites the use of “**arrays** of light emitting diodes” to generate ultraviolet light (column 4, lines 54-55 and column 6, lines 35-40 of Funk et al.) and repeatedly notes the requirement of “sequentially energized multiple light sources” (column 5, lines 8-10, 25-27). As a result, replacing the light bulb of Solomon et al. results in “arrays of light emitting diodes” and “sequentially energized multiple light sources” that necessarily require a larger housing, greater battery supply and increased cost relative to an inventive ultraviolet emitting flashlight having a single light emitting diode. Furthermore, in reading the reference as a whole, Funk et al. teaches away from the present application by teaching the use of “arrays of light emitting diodes” with “a diffuser medium to illuminate the laminated page” (column 4, lines 53-58). This is believed to represent a separate basis for the nonobviousness of claims 1, 3 and 10 over the prior art of record.

The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant’s disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that

knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” *Dembiczak*, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

On the basis of the above remarks, reconsideration and withdrawal of the rejection of claims 1, 3 and 10 under 35 U.S.C. §103(a) over Solomon et al. in view of Ristow et al. and Funk et al. is requested.

**Remarks Directed to Rejection of Claims 2, 7 and 11 Under 35 U.S.C. §103(a)
Over Solomon et al. in View of Ristow et al., Funk et al. and Prescott et al.**

Applicant hereby incorporates by reference the above remarks with respect to Solomon et al. in view of Ristow et al. and Funk et al. On the basis of these remarks and the dependency of claims 2 and 7 from independent claim 1, it is believed that these claims are likewise directed to patentable and allowable subject matter.

Applicant submits that the prior art reference combinations fails to yield the claimed invention of claims 2, 7 and 11 not only for the reasons recited above but also based on the fact that Prescott et al. fails to teach the adherence of the light source to the substrate having the printed indicia thereon. Rather, Prescott teaches the adherence of the light source to the book cover and not the book page as would be required to satisfy the limitations of the pending claims.

As such, it is submitted that the prior art reference combination fails to yield the invention as claimed. As the claim limitations not founding the prior art are entitled to patentable weight consideration, it is submitted that pending claims 2, 7 and 11 are nonobvious over the prior art reference combination of record. Reconsideration and withdrawal of the rejection of claims 2, 7 and 11 under 35 U.S.C. §103(a) over Solomon et al. in view of Ristow et al., Funk et al. and Prescott et al. is requested.

**Remarks Directed to Rejection of Claim 13 Under 35 U.S.C. §103(a)
Over Solomon et al. in View of Ristow et al., Funk et al. and Heinze III**

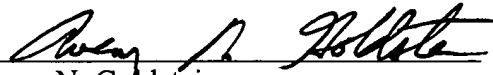
Applicant hereby incorporates by reference the above remarks with respect to claim 1, the subject matter of which is incorporated into claim 13 by reference as a basis for the allowability of claim 13. As Heinze III fails to bolster the teachings of Solomon et al., Ristow et al. and Funk et al. with respect to a motivation for placing visible ink indicia onto an ultraviolet ink indicia stationery or to provide a simple and small UV flashlight, it is submitted that claim 13 is nonobvious over the prior art reference combination. Reconsideration and withdrawal of the rejection as to claim 13 under 35 U.S.C. §103(a) over Solomon et al. in view of Ristow et al., Funk et al. and Heinze III is requested.

Summary

Claims 1-3, 7, 10, 11 and 13 are the claims pending in this application. Each claim is believed to be in allowable form and directed to patentable subject matter. Reconsideration and withdrawal of the rejections and the passing of this application to issuance are solicited. Should

the Examiner find to the contrary, he is respectfully requested to contact the undersigned attorney in charge of this application in order to resolve any remaining issues.

Respectfully submitted,


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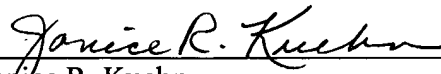
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Janice R. Kuehn

AMENDMENTS TO THE DRAWINGS

Replacement sheets 1, 2 and 3 are provided including corrections to Figures 1, 4 and 5A specifically including the inclusion of a UV LED flashlight 60 to Figure 1; a lower housing portion 90, an upper housing portion 92, a button portion 76 and a switch 70 to Figure 4; and a writeable surface 17 to Figure 5B.